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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1941.

TERNSTEDT MANUFACTURING COMPANY and GENERAL MOTORS CORPORATION,
Petitioners,
vs.
MOTOR PRODUCTS CORPORATION,
Respondent.
No. 652.

PETITIONERS' REPLY BRIEF ON PETITION FOR WRIT OF CERTIORARI.

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We will reply seriatim to Respondent's Brief.

I. This is not an ordinary patent case, but involves important questions of patent law and a situation of importance to inventors as well as those who are induced to purchase patents. There are, therefore, "special and important reasons" for the granting of the Writ as stated in this Court's Rule 38, Sec. 5; and although this Rule states that the illustrative reasons given are "neither controlling nor fully measuring the court's discretion," here the Court of Appeals "has decided a federal question in a way probably in conflict with applicable decisions of this court."

Note: All emphasis in this Reply Brief is ours.

II. The situation, in principle, is not different than it was in Schriber-Schroth v. Cleveland Trust, 305 U. S. 47, 50. Here, unless this Court reverses the Court of Appeals, Respondent can keep on as it has been doing, namely, supply the automobile industry concentrated in the Sixth Circuit and "without moving from" that Circuit; for it is not a fact (Rep. Br. p. 2) that "large quantities of the ventilating windows here in suit are made by others than Respondent"; unless we include Petitioners in those "others." It was admitted that Respondent supplies Chrysler and Hupp (R. 84) and also Ford and Willys-Overland (R. 552), all in the Sixth Circuit; and this Court can take judicial notice of the fact that those automobile manufacturers produce nearly all of the automobiles in this country not produced by General Motors. What would it then avail Petitioners to sue, with Respondent and its customers immune from the Wright patent? The fact that Petitioners can continue their use of the Wright patent cannot affect the patent question, for as this Court said in Bauer v. O'Donnell, 229 U. S. 1, 10:

> "The right to make, use and sell an invented article is not derived from the patent law. This right existed before and without the passage of the law and was always the right of an inventor. The act secured to the inventor the exclusive right to make, use and vend the thing patented, and consequently to prevent others from exercising like privileges without the consent of the patentee."

There can be no distinction made, as Respondent seeks to do (Resp. Br. p. 2), between a case where a patent has been sustained and one where it has been held invalid, because the Patent Laws, as construed by this Court, protect the rights of a patentee as well as the rights of the public; for as this Court said in United States v. Dubilier Condenser Corp., 289 U. S. 178, 186:

> "An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge." . . . "He may keep his invention secret and reap its fruits indefinitely. In consideration of its disclosure and the consequent benefit to the community, the patent is granted. An exclusive enjoyment is guaranteed him for seventeen years, but upon the expiration of that period, the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use."

III. Petitioners' contention is not simply "that the prior art did not really disclose the invention of the Wright patent," but that the Court of Appeals misinterpreted R. S. 4886 in the light of R. S. 4888, as construed by the decisions of this Court.

IV. The reasons relied on by Petitioners for the grant of the Writ are therefore not by any means that Petitioners are simply dissatisfied with the decision of the Court of Appeals.

Respondent's Statement.

Respondent's Brief states (p. 3):

> "The only thing which the patentee Wright (II, 793, I, 26) did to this conventional construction was to insert in the window opening, forwardly of the vertically slidable window pane, a pivoted wing or panel secured to the front door pillar so it might pivot about its front edge."

But such was not the finding of the Court of Appeals quoted from in the Petition (p. 12).

The fact that the identical **illustrative embodiment** of the

Wright patent was improved by Fisher of General Motors and used, cannot affect the patent in question here; for, as this Court said in Smith v. Snow, 294 U. S. 1, 11:

> "We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use, since the claims of the patent, not its specifications, measure the invention."

Here the District Court specifically found no patentable distinction between the Fisher and Wright patent embodiments (R. 765-7); that the Wright patent is "not limited to the hinging of the front panel at the front edge," and that "the construction of the Fisher patent includes that of the Wright patent" (R. 760). That appeared also to be the view of the Court of Appeals (Dec. p. 3). However, even the Wright patent embodiment was found useful and has gone into use in England in low and high priced cars (R. 228-230).

The price paid to Wright, $11,750.00 (R. 761), was certainly not "nominal" to the inventor Wright. Nor do we here simply rely upon claims added by Reissue, for here, as before the Court of Appeals, we rely on claim 8, which was in the original patent, and claim 19 which is really specific.

The development in this art which Respondent's Brief seeks to trace (p. 6), confuses that which happened after Wright filed with what happened before. The District Court's findings (12 and 16, R. 761 and 763) were that there was **no commercial use** of Wright's invention at all, not even of a wind wing, before Wright filed.

Respondent's Argument.

The argument (pp. 7-11) reference the Fennerty patent, the publication of a California Top in "Autobody" and the Stafford Car, utterly fails to take into account, that none of these have the **structure** of the Wright patent, and can, therefore, not display the **principle or mode of operation** of the Wright patent, nor secure its **result.** Respondent's argument is silent on the admissions of their own witness Brush, that none of these prior art instances had the Wright structure; (see the Blackboard exhibits 44, 45 and 49, R. 941, 943, 953, and Brush's testimony, R. 351-4 and 471). See, also, our discussion Petition pp. 9-11.

The question to and the answer of Professor Thompson (not a professional patent expert) quoted in Respondent's Brief (pp. 7-8) was "about the **operation** of the structure," as distinguished from a **structure to secure a mode of operation.** Here the prior art admittedly lacks the Wright structure and must therefore lack his mode of operation. So, also, the question to and the answer of Mr. Arnold (not a professional patent expert) quoted from in Respondent's Brief (p. 7) has reference to the **operation** of the **panels** in the Wright structure and not to the advantages secured in locating those panels in a **Wright door,** as distinguished from locating them on the **body in front of the door,** as in the California Top publication and the Stafford Car, the comparative utility of which Arnold later pointed out (R. 693-4); see our discussion (Petition pp. 8-9).

Respondent's argument before this court overlooks the fact that R. S. 4886, as construed by this court, must be construed in connection with R. S. 4888, and that a prior patent, publication, or use must possess qualifications as to definiteness of disclosure of structures and prin-

ciple, in order to strike down a presumptively valid patent. The Court of Appeals, as well as the District Court, fell into the same error. This has been shown in our Petition and Brief, particularly at pages 9, 10, 12, 25, 26 and 28.

Respectfully submitted,

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October 15, 1941.